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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/591,447	04/18/96	QUENTIN-MILLET	M XI/P02956US0

020306 HM12/0103  
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EXAMINER

PAK, M

ART UNIT	PAPER NUMBER
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1646  
DATE MAILED:

38  
01/03/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

1- File Copy

# Office Action Summary

Application No.

08/591,447

Applicant(s)

Quentin-Millet et al.

Examiner

Michael Pak

Group Art Unit

1646



☒ Responsive to communication(s) filed on Nov 13, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 83-133 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 107, 114, 115, and 125 is/are allowed.

☒ Claim(s) 83-106, 108-113, 116-124, and 126-133 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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#### DETAILED ACTION

##### *Response to Amendment*

1. The amendment filed 28 March 2000 (paper No. 32) has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Applicant's arguments filed 28 March 2000 (paper No. 32), have been fully considered but they are not found persuasive.

##### *Claim Objections*

4. Claims 108-113, 116, and 126-131 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

##### *Claim Rejections - 35 USC § 112*

5. Claims 83-106, 108-113, 116-124, and 126-131 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a Tbp2 receptor consisting of SEQ ID

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NO:2 and 4 or fragments thereof, does not reasonably provide the full scope of enablement for derivatives of Tbp2 receptor. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 83-106, 108-113, 116-124, and 126-131 encompass Tbp2 derivatives and variants because of the polypeptides are alignment protein with deletion in corresponding region which are clearly delineated. However, the specification fails to teach how to use the derivatives of Tbp2. One skilled in the art cannot predict whether such polypeptides would have any relationship to the TBP2 polypeptide. The state of the art is such that one skilled in the art cannot predict the tertiary structure of protein based on the primary amino acid sequence (Bowie et al.(S)). Thus, it would require undue experimentation to make and use variants with amino acid substitutions in the Tbp2 receptor because one skilled in the art could not predict the effect of the changes due to substitutions on the tertiary structure of the Tbp2 receptor which is necessary to determine if the protein is functional. Furthermore, changes tertiary structure will affect any antibody based on the original epitope of the natural Tbp2 protein found in the bacteria and if the antibody does not recognize the natural Tbp2 protein in the bacteria it cannot be used in diagnostic assay or for

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period for reply expire later than SIX MONTHS from the date of this final action.

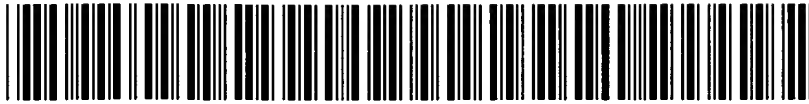
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*  
Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
29 December 2000



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Total number of pages: 5

Remarks:

Order of re-scan issued on .....